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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/135,988	08/17/98	BRYAN B	24729-105C

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EXAMINER	
WAX,R	
ART UNIT	**PAPER NUMBER**
1652	8
DATE MAILED:	08/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/135,988	Bryan
Examiner	**Group Art Unit**
Robert A. Wax	1652

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-58* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *1-58* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-19, 30-32 and 46-49, drawn to an article of manufacture/bioluminescence generating system (BGS) combination, classified in class 42, subclass 54.
II. Claims 20-22, drawn to a delivery vehicle/BGS combination, classified in class 428, subclass 402.2.
III. Claims 23 and 24, drawn to a liposome with BGS inside, classified in class 435, subclass 317.1.
IV. Claims 25-29, drawn to a matrix material/BGS combination, classified in class 525, subclass variable depending on type of matrix material.
V. Claims 33-35, drawn to a bioluminescence generating system, classified in class 435, subclass 189.
VI. Claims 36-45 and 54-58, drawn to an article of manufacture in combination with a fluorescent protein, classified in class 42, subclass 54.
VII. Claims 50-53, drawn to fish food, classified in class 426, subclass 531.

The inventions are distinct, each from the other because of the following reasons:

Inventions I - IV and V are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the bioluminescence generating system of the combination claims is not limited in form (i.e., to spray, foam or aerosol), concentration or composition. The subcombination has separate utility in the determination of ATP.

The article of manufacture of Group I, delivery vehicles of Group II, liposomes of Group III and the matrix materials of Group IV are distinct as they comprise unrelated products with different structures and unrelated utilities.

The combinations of groups I-IV are unrelated to the combination of Group VI. They are unrelated as to structure or use since fluorescent protein is different from a bioluminescence generating system.

The articles of manufacture of groups I-IV are unrelated to the composition of Group VII as they are a different statutory class of invention and are unrelated as to structure and function.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter as shown by their different classification, restriction for examination purposes as indicated is proper.

If applicant elects Group I or Group VI for prosecution the following election of species applies:

This application contains claims reciting the following patentably distinct species of the claimed invention:

toys classifiable as apparatus (balloons, guns, footbags, egg-shaped toy, water fireworks generators and bubble making toys)
toys classifiable as compositions (fairy dust, bubbles, finger paints and slimy play material)
personal care items (cosmetics, shampoos, etc.)
edible items
fountain
textiles (clothing)
paper products (greeting cards, wrapping paper)
ink
dry ice.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1and 2 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Wax whose telephone number is (703) 308-4216. The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy, can be reached on (703) 308-3804. The OFFICIAL fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Robert A. Wax
Primary Examiner
Art Unit 1652